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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,345	08/16/2001	Byung Ju Dan	2080-3-36	2636
35884	7590	11/16/2005	EXAMINER	
LEE, HONG, DEGERMAN, KANG & SCHMADEKA, P.C. 801 SOUTH FIQUEROA STREET 14TH FLOOR LOS ANGELES, CA 90017			SHAH, MILAP	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/931,345

Applicant(s)

DAN ET AL.

Examiner

Milap Shah

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,14-23 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,14-23 and 25-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

This action is in response to amendment received on 28 April 2005 in which applicant amended claims 1, 3-8, 19, 23, & 25-26 & canceled claims 2 & 24. Currently claims 1, 3-8, 14-23, & 25-28 are pending. The Examiner noticed incorrect status identifiers on claims 6 and 8 which are currently at "original" but should be "currently amended". In a response to this action an appropriate correction of the status identifiers is required.

Claim Objections

Claims 1, 15 & 20 are objected to because of the following informalities: Claims 1, 15 & 20 recite the limitation "the communication server" which appears not to have been stated before. The Examiner suggests using "a communication server" in claim 1 to avoid a 35 U.S.C. 112 rejection based on lack of antecedent basis for claims 1, 15 & 20.

Claim 19 is objected to because of the following informalities: The claim recites the limitation "a microprocessor calculating an angle change operable a toy" which is unclear, specifically the ending of "operable a toy". Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-8, 14-23 & 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabai et al. (U.S. Patent No. 6,290,566) in view of Hachiya et al. (U.S. Patent No. 6,175,857).

Claims 1, 3-8, 25-28: Gabai et al. disclose the invention substantially as claimed including a virtual character (figure 2A, element 165) for performing a motion or playing audio in a cyber space that corresponds to an actual toy (figure 2B, element 122) performing the same motions or playing the same audio in a real space (figure 2B along with the related description thereof). Gabai et al. also disclose an operating device (figure 1A, element 100 – “computer”) that inputs message information to the virtual character (column 15, line 56 – column 16, line 3) to perform the actions that are also performed by the actual toy (figure 2B, element 122) in real space, which is analogous to performing a certain motion or outputting control information (motion) corresponding to the inputted message (e.g. a “turn left” message would command the toy to turn left). Gabai et al. disclose the message information is sent or inputted to the actual toy via a communication server (figure 20, element 1250). Gabai et al. also disclose a method comprising judging whether message information is received through a

communication (figure 20, element 1250 and the related description thereof), extracting and interpreting the received communication (computer, element 100 performs operation), judging whether the interpreted message information includes designated message information (actual toy, element 122, performs this judgment), and performing a motion or playing audio by operating a toy operation software when the designated message information is present in the interpreted message information (column 13, lines 52-56, column 14, lines 22-30, & column 46, lines 20-25).

Gabai et al. specifically lack an electronic mail server supplying message information (communication) through electronic mails in a network. However, Hachiya et al. teach a mail server (figure 1, element 11D) that communicates script language via electronic mail for use by a programmable toy (figure 3, elements 103A – 103E) to perform actions based on the script language. The virtual pet performs motion or plays audio in accordance with designated message information (script language in the form of agent parameter 203 contained in electronic mail as shown in figure 10 along with the related description thereof) when the electronic mail contains such script language. Electronic mail that does not contain designated message information is handled in a conventional manner (figure 10 along the with related description thereof). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the electronic mail server taught by Hachiya et al. into the network taught by Gabai et al. to remotely program a virtual or

actual pet (considered equivalent) in order to increase excitement by allowing users to dynamically update actions performed by an actual toy in real space using a virtual toy in virtual space.

Regarding claims 3, 4, 5, 6 & 8: Hachiya et al. teach an electronic mail address of a sender and a recipient, a body part corresponding to a content to be transmitted having a script language of a designated format, and an accompanying file, which the message information uses in operation of the toy (figures 4-6, along with the related descriptions thereof).

Regarding claim 7: Hachiya et al. teach that the MIME type accompanying file format includes a header (figure 6, element 201) and toy operation data (figure 6, element 203D) including toy audio/sound data (figure 6 & 7 along with the related descriptions thereof).

Regarding claims 27 & 28: Hachiya et al. teach extracting and interpreting designated message information (script language in the form of agent parameter 203 contained in electronic mail as shown in figure 10 along with the related description thereof) from the body part and from the execution file of the electronic mail message information (column 8, lines 25-65).

Claim 14: Gabai et al. disclose that the operation device is a computer (figure 20 along with the related description thereof).

Claim 15: Gabai et al. disclose that the operation device (figure 1A, element 100) includes a virtual character (figure 2A, element 160) performing motions or playing audio in a cyber space corresponding to an actual toy (figure 2B, element 122) performing motions or playing audio in a real space (figure 28 along with the related description thereof) when inputted with message information from either the communication server (figure 20, element 1250) or the operating device (figure 1A, element 100).

Claim 16: Gabai et al. disclose that the virtual character (figure 2A, element 160) and the actual toy (figure 2B, element 122) operate interactively when a computer communication using the virtual character is performed (column 15, line 56 – column 16 line 3)

Claim 17: Gabai et al. disclose that the toy is supplied experience information of the virtual character (figure 2A, element 160) or grows according to learning performed by a user, performs a motion and outputs character information, audio information and video information (figures 35-43 along with the related descriptions thereof).

Claim 18: Gabai et al. disclose that the toy performs motions or plays audio interactive with the virtual character (figure 2A, element 160) by being inputted motion/audio information of the virtual character from the operation device or transmitting the motion/audio information thereof to the virtual character (Figures 35-43 along with the related descriptions thereof).

Claim 19: Gabai et al. disclose that the actual toy includes a memory (column 48, lines 43-45 & column 51, lines 17-21) for storing message information (commands), an input/output means (column 13, lines 60-61) for performing motions or playing audio, a wire-wireless communication means (figure 3, element 240, "antenna") for transmitting/receiving information, a microprocessor for performing operations, and an operating unit (figure 1A, element 130, "toy control unit") using the microprocessor's operation instructions (see figure 1B along with the related description thereof)

Claim 20: Gabai et al. disclose that the toy connects to the communication server (figure 20, element 1250) without passing through the operation device (computer 100) and transmits and/or receives message information with the communication server (figure 20 along with the related description thereof, wherein network computer 1270 allows connection between toy 1260 and the server 1250).

Claim 21: Gabai et al. disclose that the memory includes a motion/audio database storing certain motions, character information, audio information and video information (column 14, lines 22-40 & figures 35-43 along with the related descriptions thereof).

Claim 22: Gabai et al. disclose that the motion/audio database is constructed with motion, action, operation of the power, voice, music, audio, character and pattern or combination thereof (col. 14, lines 22-40 and Figures 35-43 along with the related descriptions thereof).

Claim 23: Gabai et al. disclose that the input/output means (column 13, lines 60-61) is constructed with a keyboard, a microphone, a sensor for inputting message information, a display unit, and a speaker outputting the inputted message information (column 13, line 60 – column 14, line 27).

Response to Arguments

Applicant's arguments filed 28 April 2005 have been fully considered but they are not persuasive. Answers to applicant's arguments are provided below.

Applicant traversed the rejection under 35 U.S.C. 102 for claim 1 specifically stating Gabai et al. (U.S. Patent No. 6,290,566) "does not teach or suggest using an electronic mail server supplying message information through electronic mails in a network". The rejection under 35 U.S.C. 102 has been withdrawn.

The rejection to claim 1 has been rewritten as a rejection under 35 U.S.C. 103 incorporating previously used references Gabai et al. and Hachiya et al. (U.S. Patent No. 6,175,857). Applicant argued that Hachiya et al. teach displaying a virtual pet on a GUI screen, but do not teach or suggest using an actual toy being inputted with the message information. The Office interprets a virtual toy and an actual toy as equivalents. One skilled in the art would deem, as an example, drawing a character on paper and drawing the same character on a video screen are equivalent drawings. This interpretation is taken in this situation to show the virtual toy and actual toy are indeed equivalent.

The applicant's argument only takes into consideration that the toy is a virtual toy rather than being an actual toy, however the original rejection under 35 U.S.C. 103 was intended to add the mail server of Hachiya et al. into Gabai et al. for use in transmitting and receiving message information to the toy, be it a virtual toy or an actual toy, as it is equivalent. Hachiya et al. was simply used to illustrate a teaching of a mail server used to transmit or receive message information to operate a virtual or actual toy. Since both inventions deal with operating toy via a server remotely, the combination creates an invention where the communication between the server and the toy is conducted via electronic mails through an electronic mail server over a network.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

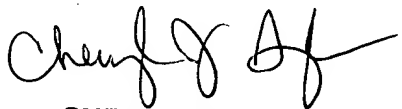
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is 571-272-1723.

The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl Tyler can be reached on 571-272-4834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.B.S.


CHERYL TYLER
SUPERVISORY PATENT EXAMINER